

JOEL MILLER
ATTORNEY AT LAW
17 WESTWOOD DRIVE SOUTH
WEST ORANGE, N.J. 07052
(973) 736-8306
FAX (973) 731-0133

October 24, 2005

RECEIVED
CENTRAL FAX CENTER
OCT 24 2005

1:24 pm

FACSIMILE MESSAGE

PLEASE DELIVER THIS IMMEDIATELY TO:

BOARD OF PATENT APPEALS
AND INTERFERENCES

VIA FACSIMILE ONLY

FAX TEL: 571-273-0299
571-273-8300

IF YOU DID NOT RECEIVE 5 PAGES, INCLUDING THIS COVER PAGE,
PLEASE CALL (973) 736-8306.

Re: Appeal No. 2005-1380
Application Serial No. 09/944,314

Contents:

Request for Rehearing (4 pages)

SHIFAX

RECEIVED
CENTRAL FAX CENTER
OCT 24 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2005-1380

Appellant: M. Masters et al.

Serial No.: 09/944,314

For: Processes for texturing the surface
of a hearing instrument

Filed: August 31, 2001

Group: 1734

Examiner: George R. Koch

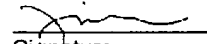
Att'y Dkt.: 2001 P 16282 US

Certificate of Transmission
Pursuant to 37 C.F.R. § 1.8

I hereby certify that this paper is being sent this
day via facsimile to 571-273-8300 and to the Board
at 571-273-0299.

Joel Miller
Attorney Name

29,955
Reg. No.


Signature

October 24, 2005
Date of Signature

Request for Rehearing

Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Via Facsimile Only

A decision on appeal was rendered in this matter on September 14, 2005. The appellants request a rehearing on the grounds that (1) the claim construction in the decision on appeal does not take into account the viewpoint of the person skilled in the art and (2) the § 103 rejection lacks proper support.

This request is timely as it is being submitted within the 60-day period set forth in 37 C.F.R. § 41.52.

The Construction of the Claims is Contrary
to the Understanding of those Skilled in the Art

Although the decision states that a claim is construed "in light of the specification as it would be interpreted by one of ordinary skill in the art" (Decision on Appeal at 6), it does not discuss or deal with this requirement. In Phillips v. AWH Corporation, 415 F.3d 1303, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005), the Federal Circuit stated that the terms of the claim should be read in the context of the application.

[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.

415 F.3d at 1313, 75 U.S.P.Q.2d at 1326. Under this standard, the appellants' claims do not read on the cited references. See also In re Cortright, 165 F.3d 1353, 1358, 49 U.S.P.Q.2d 1464, 1467 (Fed. Cir. 1999) (the construction applied to a term must be

"consistent with the one that those skilled in the art would reach"); M.P.E.P. § 2111 (8th ed., rev. 3, Aug. 2005), page 2100-47 (last paragraph in the left-hand column); Reply Brief (pp. 1-2).

The Phrase "Hearing Instrument" has Special Significance in the Art

Those skilled in the art of designing and manufacturing devices that assist the hearing impaired would not understand the phrase "hearing instrument" -- when read in the context of the specification -- to mean a telephone handset or a pair of headphones. Indeed, the records of the U.S. Patent and Trademark Office demonstrate that "hearing instrument" is a term of art. See also Reply Brief, p. 2. Thus, "the broadest reasonable interpretation" of "hearing instrument" does not "encompass any instrument or device that assists or aids in hearing" (Decision on Appeal, page 8) and, therefore, the Walter and Bowser et al. references are inapposite. Additionally, those skilled in the pertinent art would not look to a telephone handset or a pair of headphones for a solution to the problem addressed by the appellants' invention.

The Term "Texture" has not been Properly Construed

Those skilled in the art of designing and manufacturing devices that assist the hearing impaired would not understand the term "texture" -- when read in the context of the specification -- to mean a smooth surface based on the background of the appellants' invention (rejection no. 1), which describes the problem the appellants were attempting to solve and the reason for the problem - a smooth surface.

Typically, hearing devices inserted in a user's ear have a smooth or glossy finish, and the manufacturing process often includes a polishing phase to insure such a finish. Although this may provide an aesthetically pleasing appearance, the unit may have a tendency to slip out unless it has been sized to create an interference fit, in turn possibly leading to discomfort. Also, its shiny surface will make the presence of the unit in one's ear obvious to others as light reflects off the exposed surface.

Specification p. 1, lines 4-10. The application continues on page 2 line 8, stating that the problem is solved "[b]y creating a textured, non-smooth finish on the outer shell of the hearing instrument...." Nowhere in the application did the appellants admit or state that a "textured" surface is smooth. Rather, the appellants have disclaimed a smooth surface. Therefore, the characterization of the appellant's description of the problem as an admission requires a reading contrary to the specification as well as a construction contrary the understanding those skilled in the art would reach.

Reliance on Marks' handbook in support of the construction that the term "texture" encompasses a smooth surface is misplaced (Decision on Appeal, pp. 9-10). Since the specification states that a smooth surface is the cause of the problem, one skilled in this art would understand that it cannot be solved by employing the root cause.

Those skilled in the art of designing and manufacturing devices that assist the hearing impaired would not understand the term "texture" -- when read in the context of the specification -- to mean an external cover having no contact whatsoever with the ear canal

(Hoerkens). Nor does the term "texture" contemplate reinforcing ribs (Widmer et al.), as they are clearly too large and widely spaced to be considered the "texture" defined in the application. Moreover, the reinforcing ribs illustrated in the reference would likely injure the user's ear canal. See Reply Brief, p. 3.

The Term "Imparting" has not been Properly Construed

Those skilled in the art of designing and manufacturing devices that assist the hearing impaired understand the step of "imparting" -- when read in the context of the specification -- to mean a modification of the shell surface per se.

Parenthetically, resort to a dictionary definition (Decision on Appeal, p. 9) contrary to the usage of the term in the specification is improper and therefore the construction urged on the basis of that definition is not tenable. Free Motion Fitness, Inc. v. Cybex International, Inc., slip op. at 8-9 (Fed. Cir. Sept. 16, 2005) ("[t]he court must ensure that any reliance on dictionaries accords with the intrinsic evidence: the claims themselves, the specification, and the prosecution history"); Nystrom v. Trex Company, Inc., slip op. at 14 (Fed. Cir. Sept. 14, 2005) ("in the absence of something in the written description and/or prosecution history to provide explicit or implicit notice to the public -- i.e., those of ordinary skill in the art -- that the inventor intended a disputed term to cover more than the ordinary and customary meaning revealed by the context of the intrinsic record, it is improper to read the term to encompass a broader definition simply because it may be found in a dictionary, treatise, or other extrinsic source"); see also M.P.E.P. § 2111.01 (8th ed., rev. 3, Aug. 2005), page 2100-49, citing Ferguson Beauregard/Logic Controls, Division of Dover Resources, Inc. v. Mega Systems, LLC, 350 F.3d 1327, 1338, 69 U.S.P.Q.2d 1001, 1009 (Fed. Cir. 2003) ("[i]n construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor"); Brief on Appeal, p. 6.

Thus, those skilled in the art would not read the term "imparting" as described in the specification to mean the placement of an external ornamental cover on the faceplate of a hearing instrument (Hoerkens), as it is a structure separate and apart from the shell. Similarly, those skilled in the art would not understand the term "imparting" to mean encasing the shell in a sponge (Yoe et al.), as this too is based in part on an improper resort to a dictionary definition contrary to the usage in the specification.

The Correct Standard has not been Discussed or Applied

What is missing from the discussion in the Decision on Appeal and the underlying office actions is the requirement -- noted in Phillips -- to read the terms in the context of the specification from the vantage point of those in the involved in designing and manufacturing hearing instruments. Instead, the Decision on Appeal is silent on this topic.

Construed in accordance with Phillips, the claims are of appropriate scope and do not read on the cited references. Nor would the disclosures of these other references "infringe" the appellants' pending claims had they issued before the effective dates of the references.

The Skill in the Art Alone does not Establish Obviousness


"Ordinary skill" alone is an insufficient basis to support a rejection under § 103. M.P.E.P. § 2143.01 (8th ed., rev. 3, Aug. 2005), p. 2100-135, citing Al-Site Corporation v. VSI International, Inc., 174 F.3d 1308, 1324, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999) ("[s]kill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case..."); Reply Brief, p. 4. The cited portions of Hoerkens do not address the issues raised in the appellants' application -- a non-slip surface for the shell -- nor do the references provide a motivation or even a reason for modifying Widmer et al. in the manner proposed by the rejection to achieve the claimed invention. Widmer et al. has no need for the structure of Hoerkens, and Hoerkens has no need for the structure of Widmer et al., as they each address entirely separate issues. The § 103 rejection should be reversed.

Conclusion

For at least the foregoing reasons, the appellants request that the Board reconsider the decision on appeal and reverse the examiner.

Dated: October 24, 2005

Respectfully submitted,


Joel Miller
Reg. No. 29,955
17 Westwood Drive South
West Orange, N.J. 07052
(973) 736-8306
Attorney for Appellants